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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,383	08/26/2003	Kotaro Kaneko	011350-320	2047
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EXAMINER SHAN, APRIL YING				
ART UNIT 2135		PAPER NUMBER		
NOTIFICATION DATE 09/03/2008		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

### Office Action Summary

**Application No.**

10/647,383

**Applicant(s)**

KANEKO, KOTARO

**Examiner**

APRIL Y. SHAN

**Art Unit**

2135

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 11-14, 19 and 24-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 11-14, 19 and 24-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. A Request for Continued Examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 23 June 2008 has been entered.
2. Claims 1, 3-4, 11, 13-14, 19 and 25-26 have been amended. Claims 5-10, 15-18 and 20-23 have been canceled. No new claims have been added. Claims 1-4, 11-14, 19 and 24-26 are currently pending in the present application.
3. Applicant's amendments and argument have been fully considered, but are moot in view of new ground rejection as set forth below. It is noted that Applicant's arguments are directed towards limitations newly added via amendments. Any well known art statements from the last office action not argued by the Applicant are taken as admittance of prior art as per MPEP 2144.03.
4. Any objection/rejection not repeated below is withdrawn due to Applicant's amendment.

***Admitted Prior Art***

5. The examiner acknowledges Applicant's Admitted Prior art on page 1, paragraph [0003] - page 3, paragraph [0008].

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1-4, 11-14, 19 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Togawa et al. (U.S. Patent No. 5,918,008) in view of Applicant's Admitted Prior Art.

As per **claims 1, 11 and 19**, Togawa et al. discloses a computer program/method/apparatus for a controlling apparatus (controller 38 in figs. 3 and 5-9) executing the procedures of:

storing a preset list of programs that are authorized to be run on said controlling apparatus to control the image forming apparatus (original information management file 34 in fig. 3 and "The storage device 1 further includes an original information management file 34 used to manage original information of files stored on the disk 30 and original information of a virus checker prepared for inspection of the files stored on the disk" - e.g. col. 10, lines 23 - 27. Please note original information management file corresponds to Applicant's preset list of programs.);

confirming each program running on said controlling apparatus ("...an infection management table means used to manage files stored on a disk and to see if the files are infected with a virus; a table registering means for...from a virus checker for detecting if a file stored on the disk...judge if the file is infected with a virus..." - e.g. col. 2, lines 25-34 and col. 3, lines 25-39);

judging a program, which is not included in the preset list of programs that are authorized to be run to control the image forming apparatus among programs whose running states have been confirmed, as an illegal resulting from a computer virus infection (step s151 in fig. 15, steps S181, 182 and 184 fig. 18 and "...an infection management table means used to manage files stored on a disk and to see if the files are infected with a virus; a table registering means for...from a virus checker for detecting if a file stored on the disk...judge if the file is infected with a virus..." - e.g. col. 2, lines 25-34. Togawa et al. further discloses a version update information management file 35 is used to manage differential information due to modification concerning a file stored on the disk 30 and history information due to the modification and file information management file 36 is used to manage the information indicating if the files are stored the disk, and is used to determine if the original information stored in the original information management file 34, and the differential information (brought about due to modification and which is stored in the version upgrade information management file 35) are infected with viruses" – e.g. col. 10, lines 23-52. *In another words, Togawa et al.'s preset list of programs (i.e. original information management file 34) can be modified and need to go through virus check before running*); and

deleting or isolating the program that is judged to be illegal program (e.g. step s211 in fig. 21 and "and a prohibiting means that when the judging means has judged that a file is infected with a virus, prohibits the use of the file" – e.g. col. 2, lines 34-36).

Togawa et al. does not expressly disclose controlling apparatus (i.e. controller) intended to control image forming apparatus.

However, Applicant's Admitted Prior Art discloses on paragraph [0005] on page 2 of the Applicant's original disclosure, "A technology has been developed in recent years that uses a personal computer loaded with a general purpose operating system as a controlling apparatus for controlling an image forming apparatus such as a Multi-Function Peripheral (MFP) instead of using hardware designed specifically for such an image forming apparatus...".

It would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate Applicant's Admitted Prior Art's controlling apparatus intended to control image forming apparatus motivated by to prevent controlling apparatus that controls the image forming apparatus to get infected by computer viruses.

As per **claims 2, 12 and 24**, Togawa et al. – Applicant's Admitted Prior Art discloses a computer program as applied above in claim 6. Togawa et al. further discloses executes a procedure of automatically deleting or isolating the file that is judged as illegal file (e.g. step s211 in fig. 21).

As per **claims 3-4, 13-14 and 25-26**, Togawa et al. further discloses wherein the procedure of judging includes a procedure of comparing the name of each file whose existence has been confirmed with the name of each file included in said list and wherein the procedure of judging includes a procedure of comparing the size of each file whose existence has been confirmed with the size of each file included in said list ("...judged...in terms of the file name..." – e.g. col. 3, lines 31-39; col. 5, lines 25-29; "...when the size of a file is varied by running the file...judges..." – e.g. col. 3, lines 26-30 and col. 5, lines 20-23)

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (See PTO -892)

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to APRIL Y. SHAN whose telephone number is (571)270-1014. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/April Y Shan/  
Examiner, Art Unit 2135  
/KimYen Vu/  
Supervisory Patent Examiner, Art Unit 2135